

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 3672
)	
Jackson et al.)	Examiner: SINGH, SUNIL
)	
Serial No.: 10/688,216)	Confirmation No.: 7252
)	
Filed: 10-15-2003)	<u>REQUEST FOR CONSIDERATION OF</u>
)	<u>INFORMATION DISCLOSURE</u>
Atty. File No.: 5885-1)	<u>STATEMENT SUBMITTED JUNE 28,</u>
)	<u>2004</u>
For: AUTOMATED EXCAVATION)	
MACHINE)	Electronically Submitted

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On June 28, 2004, Applicants submitted an Information Disclosure Statement (IDS) in the above-identified patent application. The Information Disclosure Statement, including the non-patent literature reference, is attached hereto as Exhibit A.

On September 4, 2009, the Examiner issued a Notice of Allowance for the above-identified case. A review of the file has indicated that the Examiner has yet to consider the IDS filed on June 28, 2004.

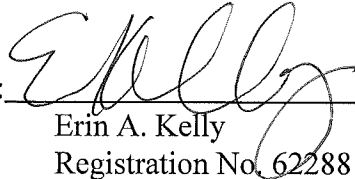
Applicants hereby respectfully request that the Information Disclosure Statement of June 28, 2004, be considered by the Examiner.

Although no fees are believed due in connection with this communication, please charge any fees deemed necessary to Deposit Account No. 19-1970. If additional information is required please contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: _____



Erin A. Kelly

Registration No. 62288

1560 Broadway, Suite 1200

Denver, Colorado 80202-5141

(303) 863-9700

Date: 12-4-09

Exhibit A



6-30-04

IFW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

JACKSON et al.

Serial No.: 10/688,216

Filed: October 15, 2003

Atty. File No.: 4770-37

For: "AUTOMATED EXCAVATION
MACHINE"

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Group Art Unit: 3673

Examiner: KRECK, JOHN J.

FIRST SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT

"EXPRESS MAIL" MAILING LABEL NUMBER: EV 368039060US
DATE OF DEPOSIT: 6/28/04

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING
DEPOSITED WITH THE UNITED STATES POSTAL SERVICE
"EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE
UNDER 37 C.F.R. 1.10 ON THE DATE INDICATED ABOVE AND IS
ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX
1450, ALEXANDRIA, VA 22313-1450.

TYPED OR PRINTED NAME: Barbara Tyndall

SIGNATURE: *Barbara Tyndall*

Dear Sir:

The references cited on attached Form PTO-1449 are being called to the attention of the Examiner.

☐ Copies of the cited non-patent and/or foreign references are enclosed herewith.

☐ Copies of the cited U.S. patents/patent application publications are not enclosed in
accordance with the waiver dated July 11, 2003, whereby patent applications filed after June 30, 2003 and
international applications that have entered the national stage under 35 U.S.C. § 371 after June 30, 2003 need
not submit copies of U.S. patents and U.S. patent application publications.

☐ Copies of the cited references are not enclosed, in accordance with 37 C.F.R. 1.98(d),
because the references were submitted to the U.S. Patent and Trademark Office in prior application Serial No.
_____ filed _____, which is relied upon for an earlier filing date under 35 U.S.C. §
120.

☐ To the best of applicants' belief, the pertinence of the foreign-language references are
believed to be summarized in the attached English abstracts and in the figures, although applicants do not
necessarily vouch for the accuracy of the translation.

☐ Examiner's attention is drawn to the following co-pending applications, copies of which have
been or are being submitted:

Serial No. _____ filed _____

Serial No. _____ filed _____

☒ Other: Invitation to Pay Additional Fees attaching Results of Partial International Search

Submission of the above information is not intended as an admission that any item is citable under the statutes or rules to support a rejection, that any item disclosed represents analogous art, or that those skilled in the art would refer to or recognize the pertinence of any reference without the benefit of hindsight, nor should an inference be drawn as to the pertinence of the references based on the order in which they are presented. Submission of this statement should not be taken as an indication that a search has been conducted, or that no better art exists.

It is respectfully requested that the cited information be expressly considered during the prosecution of this application and the references made of record therein.

FEES

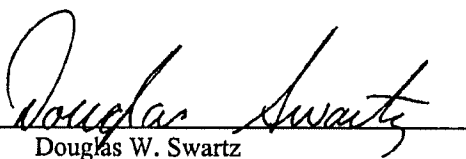
<input type="checkbox"/>	<p>37 CFR 1.97(b): No fee is believed due in connection with this submission, because the information disclosure statement submitted herewith satisfies one of the following conditions ("X" indicates satisfaction):</p> <ul style="list-style-type: none"> <input type="checkbox"/> Within three months of the filing date of a national application other than a continued prosecution application under 37 CFR 1.53(d), or <input type="checkbox"/> Within three months of the date of entry into the national stage of an international application as set forth in 37 CFR 1.491 or <input type="checkbox"/> Before the mailing date of a first Office Action on the merits, or <input type="checkbox"/> Before the mailing of a first Office action after the filing of a request for continued examination under 37 CFR 1.114. <p>Although no fee is believed due, if any fee is deemed due in connection with this submission, please charge such fee to Deposit Account 19-1970.</p>
<input type="checkbox"/>	<p>37 CFR 1.97(c): The information disclosure statement transmitted herewith is being filed after all the above conditions (37 CFR 1.97(b)), but before the mailing date of one of the following conditions:</p> <ul style="list-style-type: none"> (1) a final action under 37 C.F.R. 1.113 or (2) a notice of allowance under 37 C.F.R. 1.311, or (3) an action that otherwise closes prosecution in the application. <p>This Information Disclosure Statement is accompanied by:</p> <ul style="list-style-type: none"> <input type="checkbox"/> A Certification (below) as specified by 37 C.F.R. 1.97(e). Although no fee is believed due, if any fee is deemed due in connection with this submission, please charge such fee to Deposit Account 19-1970. <p style="text-align: center;">OR</p> <ul style="list-style-type: none"> <input type="checkbox"/> Please charge Deposit Account 19-1970 in the amount of \$180.00 for the fee set forth in 37 C.F.R. 1.17(p) for submission of an information disclosure statement. Please credit any overpayment or charge any underpayment to Deposit Account 19-1970.

<input type="checkbox"/>	<p>37 CFR 1.97(d): This Information Disclosure Statement is being submitted after the period specified in 37 CFR 1.97(c).</p> <p style="padding-left: 40px;"><input type="checkbox"/> This information Disclosure Statement includes a Certification (below) as specified by 37 C.F.R. 1.97(e)</p> <p style="text-align: center;">AND</p> <p style="padding-left: 40px;"><input type="checkbox"/> Applicants hereby requests consideration of the reference(s) disclosed herein. Please charge Deposit Account 19-1970 in the amount of \$180.00 under 37 C.F.R. 1.17(p). Please credit any overpayment or charge any underpayment to Deposit Account 19-1970. Election to pay the fee should not be taken as an indication that applicant(s) cannot execute a certification.</p>
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<p>Certification (37 C.F.R. 1.97(e)) (Applicable only if checked)</p> <p><input type="checkbox"/> The undersigned certifies that:</p> <p style="padding-left: 40px;"><input type="checkbox"/> Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement. 37 C.F.R. 1.97(e)(1).</p> <p style="padding-left: 80px;"><input type="checkbox"/> A copy of the communication from the foreign patent office is enclosed.</p> <p style="text-align: center;">OR</p> <p style="padding-left: 40px;"><input type="checkbox"/> No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. 1.56(c) more than three months prior to the filing of this statement. 37 C.F.R. 1.97(e)(2).</p>

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 
 Douglas W. Swartz
 Registration No. 37,739
 1560 Broadway, Suite 1200
 Denver, Colorado 80202-5141
 (303) 863-9700

Date: June 28, 2004

PATENT COOPERATION TREATY

RECEIVED

APR 14 2004

SHERIDAN, ROSS

PCT

From the INTERNATIONAL SEARCHING AUTHORITY

INVITATION TO PAY ADDITIONAL FEES

(PCT Article 17(3)(a) and Rule 40.1)

To:

SHERIDAN ROSS P.C.
Attn. Swartz, Douglas W.
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
UNITED STATES OF AMERICA

REGISTERED MAIL

Date of mailing
(day/month/year)

05/04/2004

Applicant's or agent's file reference

4770-37-PCT

PAYMENT DUE

within 45 ~~XXXX~~ days
from the above date of mailing

International application No.

PCT/IB 03/05356

International filing date
(day/month/year)

15/10/2003

Applicant

PLACER DOME TECHNICAL SERVICES LIMITED

1. This International Searching Authority

- (i) considers that there are 6 (number of) inventions claimed in the international application covered by the claims indicated ~~XXXX~~ on the extra sheet:

and it considers that the international application does not comply with the requirements of unity of invention (Rules 13.1, 13.2 and 13.3) for the reasons indicated ~~XXXX~~ on the extra sheet:

- (ii) ☒ has carried out a partial international search (see Annex) ☐ will establish the international search report on those parts of the international application which relate to the invention first mentioned in claims Nos.:

1-38, 60-74

- (iii) will establish the international search report on the other parts of the international application only if, and to the extent to which, additional fees are paid

2. The applicant is hereby invited, within the time limit indicated above, to pay the amount indicated below:

EUR 945,00 x 5 = EUR 4 725,00
Fee per additional invention number of additional inventions total amount of additional fees

Or, _____ x _____ = _____

The applicant is informed that, according to Rule 40.2(c), the payment of any additional fee may be made under protest, i.e., a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive.

3. ☐ Claim(s) Nos. _____ have been found to be unsearchable under Article 17(2)(b) because of defects under Article 17(2)(a) and therefore have not been included with any invention.

Name and mailing address of the International Searching Authority



European Patent Office, P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Sonia Kaufmann

Annex to Form PCT/ISA/206
COMMUNICATION RELATING TO THE RESULTS
OF THE PARTIAL INTERNATIONAL SEARCH

International Application No
PCT/IB 03/05356

1. The present communication is an Annex to the invitation to pay additional fees (Form PCT/ISA/206). It shows the results of the international search established on the parts of the international application which relate to the invention first mentioned in claims Nos.:
1-38, 60-74
2. This communication is not the international search report which will be established according to Article 18 and Rule 43.
3. If the applicant does not pay any additional search fees, the information appearing in this communication will be considered as the result of the international search and will be included as such in the international search report.
4. If the applicant pays additional fees, the international search report will contain both the information appearing in this communication and the results of the international search on other parts of the international application for which such fees will have been paid.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 4 548 442 A (SUGDEN DAVID B ET AL) 22 October 1985 (1985-10-22) column 16, line 25 - line 35; figures 6-9	1-38
X	US 6 062 650 A (HAYES JACK R ET AL) 16 May 2000 (2000-05-16) column 9, line 9 - column 10, line 9; figures 1,2	1-38

☐ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents :

A document defining the general state of the art which is not considered to be of particular relevance

E earlier document but published on or after the international filing date

L document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

O document referring to an oral disclosure, use, exhibition or other means

P document published prior to the international filing date but later than the priority date claimed

T later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

X document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

Y document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

Z document member of the same patent family

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This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

1. Claims: 1-38, 60-74

An excavator with a boom, a cutter head, a body, grippers and a control system for effecting operation of the excavator in a manual mode and in an automatic mode.

2. Claims: 39-43

An excavator with a rotatable boom actuated by first and second swing actuators with minimum and maximum strokes.

3. Claims: 44-46

A method for operating an excavator including a plurality of hydraulic actuators, check valves and hydraulic fluid lines in fluid communication with the check valves, wherein a fault detected in the hydraulic system leads to the closing of the check valves and drainage of the hydraulic fluid from the hydraulic actuators.

4. Claims: 47-52

A method for operating an excavator comprising a body, a cutter head and a plurality of hydraulic actuators with fluid containing cavities providing pressure control or position control functions.

5. Claims: 53-56

A method for realizing pitch and roll adjustments in an excavator.

6. Claims: 57-59

An automated method for excavating material with an excavator comprising a boom and a memory storing a profile of an excavation face wherein the profile is revised and updated in the memory after rotation of the boom removing material from the face.

According to the description p.3, 1.28-31, the technical problem solved by the first group of inventions is to reduce danger to personnel during excavation operations.

According to the description p.2, 1.22-24, the technical problem solved by the second group of inventions is to provide a more effective torque profile throughout the rotational cycle of the boom.

According to the description p.2, 1.25-26, the technical problem solved by the third group of inventions is to provide a fail safe hydraulic system to maintain gripper pressure in the event of a malfunction of the hydraulic system.

According to the description p.3, 1.1-3, the technical problem solved by the fourth is to provide different control functions for the hydraulic

actuators.

According to the description p.3, 1.18-20, the technical problem solved by the fifth group of inventions is to provide an excavator for excavating dipping orebodies.

According to the description p.3, 1.14-17, the technical problem solved by the sixth group of inventions is to configure automatically the boom swing parameters for optimizing the excavator operation.

The different groups of inventions therefore solve different technical problems with different technical features. No technical relationship among the different groups of inventions involving the same or corresponding special technical features can be determined. The application does therefore not fulfill the requirement of unity of invention in the sense of Rule 13.1 PCT as the groups of inventions are not so linked as to form a single general inventive concept.

The application relates to a plurality of inventions, or groups of inventions, in the sense of Rule 13.1 PCT. They have been divided as defined above. If the applicant pays additional fees for one (or more) not yet searched group(s) of invention(s), then the further search(es) may reveal further prior art that gives evidence of a further lack of unity 'a posteriori' within one (or more) of the not yet searched group(s). In such a case only the first invention in this (each of these) group(s) of inventions, which is considered to lack unity of invention, will be the subject of a search.

No further invitation to pay further additional fees will be issued. This is because Article 17(3)(a) PCT stipulates that the ISA shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ('main invention') and for those parts which relate to inventions in respect of which the additional fees were paid. Neither the PCT nor the PCT guidelines provide a legal basis for further invitations to pay further additional search fees (W17/00, point 11 and W1/97, points 11-16).

It is pointed out that claims 6, 7, 12, 16, 24-26, 28-30 have been searched inasmuch as they are dependent on claim 1 and do therefore comprise the same technical features and solve the same technical problem.

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Patent Family Annex
Information on patent family members



International Application No
PCT/IB 03/05356

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
US 4548442	A	22-10-1985	AU 563322 B2	02-07-1987
			AU 3672184 A	26-06-1985
			CA 1218388 A1	24-02-1987
			DE 3490570 T	29-01-1987
			EP 0164371 A1	18-12-1985
			JP 4044074 B	20-07-1992
			JP 61500620 T	03-04-1986
			SE 468522 B	01-02-1993
			SE 8503672 A	01-08-1985
			WO 8502653 A1	20-06-1985
			ZA 8409431 A	31-07-1985
US 6062650	A	16-05-2000	CA 2141984 A1	08-08-1996
			AT 174658 T	15-01-1999
			AU 691073 B2	07-05-1998
			AU 4478696 A	27-08-1996
			WO 9624753 A1	15-08-1996
			DE 69601156 D1	28-01-1999
			DE 69601156 T2	20-05-1999
			EP 0807203 A1	19-11-1997
			FI 973242 A	06-10-1997
			JP 10513517 T	22-12-1998
			NO 973636 A	06-10-1997
			NZ 300131 A	19-12-1997
			ZA 9600650 A	03-10-1996

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